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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,971	09/05/2002	Sheng-Chih Lin	CHEP0009USA	7018
27765	7590	08/07/2006	EXAMINER	
NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116			ROHWER, JACOB P	
			ART UNIT	PAPER NUMBER
			2625	
DATE MAILED: 08/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/064,971	LIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jacob P. Rohwer	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 8-10 and 12-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No 5,287,158 to Nagashima et al, in view of US Patent No 6,970,259 to Lunt et al.

Regarding claim 1, Nagashima discloses a method for preventing repeat printing to a document by a printer (**Fig 4**), the printer comprising a sensor (**Fig 3 #16**), the printer capable of receiving the document and printing data onto a copy of the document, the method comprising:

receiving the document; (**Fig 6 S200**)

determining if the document has a printing data using the sensor; (**Fig 6 S202**)

printing data onto a the document with the printer when the document does not have printing data;(**Fig 6 S203**) and

not printing data onto the document with the printer when the document already has printing data. (**Fig 6 S204**)

Although Nagashima discloses determining registered marks on the document in another embodiment (**Fig 8 S404**), Nagashima does not expressly disclose using sensor to detect the sign in order to prevent printing, and further does not disclose

printing a sign onto the document with the printer when the document does not have the printing sign after print data has been printed on the document.

However, Lunt has been found to disclose a system, where marks are printed on documents in order to identify a protection level of the document. **(Col 10 Lin 30-41)** As a result these marks help determine whether the document can be output or not in the future.

The Nagashima and the Lunt Patents are combinable because they both come from the same field of endeavor relating to determining of print data should be output or not using the detection of markings. Both systems incorporate the detection of pre-registered marks in order to determine if output, copying or printing, can and should be carried out.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the technology of marking a sheet or page in order to prevent future output as specified in Lunt, in order to determine if a sheet has already been printed on as specified in Nagashima.

The suggestion/motivation for doing so would have been to save processing time by only requiring the sensor to look for a sign in a particular area instead of having to scan the whole sheet for print data as disclosed in Nagashima.

Therefore, it would have been obvious to combine the Nagashima and Lunt Patents in order to obtain the invention as specified in claim 1.

Regarding claim 2, the combination further discloses the method of claim 1 wherein the printer prints data onto the document inside a print area of the document;

and the printer prints the printing sign onto the document outside the print area of the document. **(Lunt, Col 10 Lin 38-41 discloses the mark is printed in the margin of the output document, which would be outside the print area of the print data.)**

Regarding claim 3, the combination further discloses the method of claim 1 wherein the printing sign is a sign inside a print area of the document. **(It is known that if that if a printer is capable of printing a sign on a sheet, then that sign is within a print area of the document.)**

Regarding claim 8, the combination further discloses in Nagashima the method of claim 1 wherein the printer further comprises a capstan roller and a pinch roller capable of driving the document forward and backward. **(Fig 3 #25 and #5, Col 2 Lin 30-35)**

Regarding claim 9, the combination further discloses in Nagashima the method of claim 8 wherein the printer further comprises a motor that drives the capstan roller to rotate. **(Fig 4 #36, Col 4 Lin 9-11)**

Regarding claims 10 and 12-14, the combination further discloses in Nagashima the method of claim 1 wherein the printer is a thermal transfer printer (claim 10), a dot matrix printer (claim 12), an inkjet printer (claim 13) and an electrostatic printer (claim 14). **(Col 2 Lin 24-26 and Col 7 Lin 45-48)**

**Claims 4-7 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Nagashima and Lunt as specified in claim 1 above, in view of commonly known prior art at the time of the invention.

Regarding claims 4-7, the claims are directed toward a thermal transfer color (claim 7) printer (claims 6) and its components, an ink ribbon and print head (claim 4), and a platen roller (claim 5). Official notice is taken, that at the time of the invention, it would have been obvious to include these components in the thermal transfer printer as disclosed in Nagashima.

The suggestion/motivation for doing so would have been to provide an efficient thermal transfer printer according to common technology within the art of thermal transfer printing.

Regarding claim 11, the claim is directed toward the printer of claim 1 being a thermal inkjet printer. Again, official notice is taken that at the time of the invention it would have been obvious for one of ordinary skill in the art to use this printing technique in the printer as specified in the combination of Nagashima and Lunt.

The suggestion/motivation for doing so would have been to apply the method specified to the variety of printers in the consumer market.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection. The Nagashima Patent has been found as a reference disclosing a method to prevent repeat printing, and in combination with the Lunt Patent which discloses using marks to prevent future output, discloses the claimed limitations as amended in the current application.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob P. Rohwer whose telephone number is 571-272-5509. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PR

KA Williams

7/27/06

KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER